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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/311,837	05/14/99	BARTA	T MON-116.6

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HM12/0503

EXAMINER

CHANG, C

ART UNIT

PAPER NUMBER

1625

14

DATE MAILED: 05/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/311,837

Applicant(s)

BARTA ET AL.

Examiner

Celia Chang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 10 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 7-33,35-42,52-65,67-85,87-94 and 128-131 is/are pending in the application.
- 4a) Of the above claim(s) 86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 7-33,35-42,52-65,67-85,87-92,94 and 128-131 is/are rejected.
- 7) ☐ Claim(s) 93 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 & 8.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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### DETAILED ACTION

1. This is a CPA of SN 09/311,837. Applicants have elected group II, claims 93-94 in Paper No. 6 without traverse. Generic claims 41-42, 52-85, 87-92, 128-131 is prosecuted to the extend that one of X,Y,Z is O and the others are C,  $m+n+p=3$ , together with the method claims 7-33, and 35-40 to the same extend of the compounds limited to treating angiogenesis.

A preliminary amendment in Paper No. 13 dated Jan. 10, 2001 has been entered cancelling claims 1-6, 34, 43-51, 66, 95-127, and 132-146 (please check the correctness in cancelling claim 66)

Prosecution continues for the same claims 41-42, 52-65, 67-85, 87-92, 128-131 being drawn to the elected invention. The remaining compounds of claims 41-42, 52-65, 67-85, 87-92, 128-131 and methods of 7-33, 35-40, and claim 86 are withdrawn from consideration per 37 CFR 1.142(b).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 94, 41-42, 52-65, 67-85, 87-92, 128-131, 7-33, 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender et al. US 5,932,595.

Determination of the scope and content of the prior art (MPEP §2141.01)

Bender et al. '595 disclosed homologous compounds of the claims (see col. 5, lines 4-10, 30-49, 52-68, col. 6 lines 1-13).

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Bender et al. '595 disclosed all the elements of the claims **except** the insertion of one methylene chain between the ring and the side chain.

Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)

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The difference of one methylene linkage is considered a prima facie structural modification within the teaching of the prior art in absence of unexpected results. Decision for such situation is truly monumental such as found in *In re Ruddy* 121 USPQ 427; *Exparte Gresham* 121 USPQ 422; *Exparte Nathan* 121 USPQ 349.

3. The text of those sections of Title 35, U.S. Code can be found supra in section 2.

Claims 41-42, 52-85, 87-92, 128-131, 7-33, 35-40 are provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over the national stage application of Venkatesan et al. WO 98/37877 (cited on 1449).

It is noted that the WO 98/37877 patent has a US priority date prior to the provisional date of the instant parent application. Venkatesan et al. disclosed the instantly claimed tetrahydropyranyl compounds generically. The species of example 86, 96 and 99 under the generic guidance disclosed on pages 9-10 wherein R2 and R3 can optionally be piperidine or tetrahydropyranyl rendered the instant claims obvious.

4. Claims 94, 41-42, 52-65, 67-85, 87-92, 128-131, 7-33, 35-40 are provisionally rejected under 35 USC 103(a) as being unpatentable over the national stage application of Benkatesan et al. WO 98/37877 in view of Bender et al. '595.

The rationale as delineated in section 3 is also applicable here. The difference between claim 94 and the prior art is the substitution of the phenoxy ring with a trifluoromethyl moiety. Trifluoromethyl is an alternative choice of substituent as disclosed in analogous art, see Bender et al. '595, col. 6 line 63.

5. Claim 93 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner can be reached by facsimile at (703) 308-7922 with courtesy voice message supra.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

CCPC/Chang

Apr. 26, 2001



CEILA CHANG  
PRIMARY EXAMINER  
GROUP 1200/605